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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,491	04/04/2007	Werner Mannschedel	BOET 22.673(336348-00019)	2754
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KATTEN MUCHIN ROSENMAN LLP			EIDE, HEIDI MARIE	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/587,491

**Applicant(s)**

MANNSCHEDEL ET AL.

**Examiner**

HEIDI M. EIDE

**Art Unit**

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 12-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the microcapsules and the adhesion promoter in the color layer must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

The substitute specification filed 12/23/2008 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: Not all of the added subject matter is underlined, therefore it is not clear what all was added.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanel GB 1,477,107 in view of Hamilton et al. 2004/0214134 (Hamilton). Hanel teaches an articulating sheet for use in dentistry, which comprises a support layer 5 that is provided on one side with one color layer comprising a coloring pigment, characterized in that there is present on the one color layer, a layer that has at least one adhesion promoter for the coloring pigment on the color layer characterized in that the adhesion promoter is capable of promoting the adhesion of coloring pigments onto a tooth (col. 1, ll. 23-35, col. 2, ll. 46-50). As to claim 15, Hanel teaches the invention as discussed above, as to the limitation of the color layer having an adhesion promoter in the color layer, it is noted that one the sheet has been used the layers will be intermixed meeting the limitation. Applicant teaches on page 6, par. 3 that the adhesion promoter may be waxes, as taught by Hanel, therefore the articulating sheet taught by Hanel is capable of functioning as claimed. Hanel teaches the articulating sheet is foil and not

specifically paper and does not specifically teach the color layer is colored wax color layer. Hamilton teaches the articulating sheet may be paper or foil and a support layer 20 that is paper (par. 22) and the colored layer may be a colored wax layer (par. 28). It would have been an obvious matter of design choice to one having ordinary skill in the art at the time of the invention to modify Hanel in view of Hamilton as a matter of obvious design choice and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (*In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) MPEP 2144.07).

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanel GB 1,477,107 in view of Hamilton et al. 2004/0214134 (Hamilton) as applied to claim 1 above, and further in view of Gallopo et al. 5,077,051 (Gallopo). Hanel in view of Hamilton teach the invention as discussed above, including Hamilton teaching the use of microcapsules suitable for releasing the material in the microcapsule as a result of an activator, which is pressure (par. 23). Hanel in view of Hamilton does not teach that the adhesion promoter is encapsulated in the microcapsules. Gallopo teaches the adhesion promoter is encapsulated in the microcapsules (see abstract). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Hanel in view of Hamilton further in view of Gallopo in order to keep the coloring layer and adhesive separated before use to prevent premature use of the sheet.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanel GB 1,477,107 in view of Hamilton et al. 2004/0214134 (Hamilton) in view of Gallopo et al.

5,077,051 (Gallop) as applied to claim 5 above, and further in view of Gottschalk et al. 5,035,621 (Gottschalk). Hanel in view of Hamilton in view of Gallop teach the invention as discussed above, however, does not teach the microcapsules are suitable for releasing the material contained within them as a result of UV irradiation of the microcapsules. Gottschalk teaches the microcapsules are suitable for releasing the material contained within them as a result of UV irradiation of the microcapsules (col. 1, ll. 30-37, 50-60). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Hanel in view of Hamilton in view of Gallop further in view of Gottschalk as a matter of obvious design choice, since the applicant teaches in the last par. on page 2 continuing on to page 3 several different activators for releasing the material in the microcapsules but does not claim criticality to any specific methods.

Claim 7 rejected under 35 U.S.C. 103(a) as being unpatentable over of Hamilton et al. 2004/0214134 (Hamilton) in view of Gallop et al. 5,077,051 (Gallop) as applied to claim 5 above, and further in view of Fujiwara et al. 6,244,864 (Fujiwara). Hanel in view of Hamilton in view of Gallop teach the invention as discussed above, however, does not teach the microcapsules are suitable for releasing the material contained within them as a result of heat of the microcapsules. Fujiwara teaches the microcapsules are suitable for releasing the material contained within them as a result of heat of the microcapsules (col. 14, ll. 57-63). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Hanel in view of Hamilton in view of Gallop further in view of Fujiwara as a matter of obvious design choice, since the applicant teaches in the last par. on page 2 continuing on to page 3

several different activators for releasing the material in the microcapsules but does not claim criticality to any specific methods.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-7 and 12-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 9-14 of copending Application No. 10/587621 in view of Kokal Jr. 3,959,881. 881 teaches an articulating sheet wherein the sheet comprises multiple color layers (col. 2, ll. 81-54). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify 621 in view of 881 to include multiple color layers as a matter of obvious design choice since 881 teaches a single layer and multiple layers of color.

This is a provisional obviousness-type double patenting rejection.

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEIDI M. EIDE whose telephone number is (571)270-3081. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**Heidi Eide**  
**Examiner**  
**Art Unit 3732**

**/John J Wilson/**  
**Primary Examiner**  
**Art Unit 3732**

/Heidi M Eide/



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3/3/2008